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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/522,345	03/10/2005	Mark Beckmann	112740-1051	6320

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EXAMINER

PATEL, NIMESH

ART UNIT	PAPER NUMBER
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2617

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/04/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/522,345	Applicant(s) BECKMANN ET AL.	
	Examiner Nimesh Patel	Art Unit 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 March 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16 - 30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16 - 30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>Jan. 24, 2005</u> | 6) <input type="checkbox"/> Other: _____ |

Detailed Office Action

1. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims rejection – 35 U.S.C. 112 2nd paragraph

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 16, 23 and 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The applicant claims "polling specific subscriber data of the wireless local network", is this kind of downloading the data from the network specific to subscriber and stored at UICC? Say, the subscriber is roaming between different

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networks, and the NEW subscriber data needs to be downloaded for the new network.

The question is what happens after an UMTS terminal is polling data of the wireless local network?

Or is this subscriber data is polled from the UICC?

This makes the claim indefinite, as it is OPEN ENDED after polling the data from the network.

Claims 20 – 22 and 27 – 29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The word “suitable” is used in the claims for notifying/initiating/acknowledging.

The examiner interprets the word “suitable” as the suggestive use, it is NOT 100% sure that it will perform the claimed features.

Claims Rejection – 35 U.S.C. 103(a)

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 16 – 19, 23 - 26, 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reddy, US PGPub: US 2004/0043791A1 Mar. 4, 2004, provisional application 60/382,361 May 22, 2001, and in view of Le, US Patent: US 6,556,820 B1, Apr. 29, 2003.

Regarding claims 16, 23 and 30, which claims, “a wireless local network”, Reddy discloses, a Wireless Local Area Network – WLAN (paragraphs 0031 and 0037, claims 20 and 23).

Further claimed feature, “a UMTS terminal station having USIM/SAT functionality”, Reddy discloses, in 3rd Generation – 3G Universal Mobile Telecommunication Systems – UMTS, User Equipment – UE consists of Mobile Equipment – ME and a removable smart card called the UMTS Subscriber Identity Module – USIM (Fig. 1, and paragraphs 0003, 0004, 0006, 0007, 0015, 0016 and 0030).

Further claimed feature, “parts for monitoring activity of the wireless local network”, Reddy discloses, when request to connect the MS 110 is received – S1, the PLMN and IMSI information is transferred from the USIM or SIM card 115 to the handset 110 for facilitating an initial cell search and to camp on the cell

determined from the search – S2. After successful camping on a cell MS or UE receives system information. A communication link between the MS or UE 105 and a UTRAN node 120 is established, and system information is sent from the UTRAN node 120 to the MS or US 105 – S3A and S3B (Fig. 1). The handset has unique handset identity for transmitting, receiving and processing wireless communications. The handset selectivity transmits information to one or more networks for establishing a communication link with the networks.

Here, the handset is searching for cell, teaches the handset is monitors the network, and after successful searching, the handset receives system information, so the handset has claimed parts for monitoring activity of the wireless local network (paragraph 0016).

Further claimed feature, “after successful detection of local network activity, parts for transmitting at least one of a type and an identity number of the wireless local network to the terminal station”, Reddy discloses, After successful camping on a cell MS or UE receives system information. A communication link between the MS or UE 105 and a UTRAN node 120 is established, and system information is sent from the UTRAN node 120 to the MS or US 105 – S3A and S3B (Figs. 1, 4/S10, 5/S16B, 6/S22B, and 7/S29B).

Further claimed feature, “parts for **initiating** a logical connection between the wireless local network and the terminal station”, Reddy discloses, the handset

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220 or UE 105 sends a connection request including the stored IMSI information to the Core Network 125 through UTRAN node 120 or with IP address (Figs. 4/S9 and S11, 5/S17, 6/S23, 7/S30). Here, the handset is initiating a logical connection between the handset and core network, through UTRAN Node 120. Here, Reddy teaches, once the mobile unit receives the system information, the mobile initiates the connection request with IP address and/or User information to UTRAN node 120,

but, is silent on "parts for polling specific subscriber data of the wireless local network".

Reddy discloses, when request to connect the MS 110 is received – S1, the PLMN and IMSI information is transferred from the USIM or SIM card 115 to the handset 110 for facilitating an initial cell search and to camp on the cell determined from the search – S2. After successful camping on a cell MS or UE receives system information. A communication link between the MS or UE 105 and a UTRAN node 120 is established, and system information is sent from the UTRAN node 120 to the MS or US 105 – S3A and S3B (Fig. 1), as above.

Here, the handset is searching for cell, teaches the handset is monitors the network and collecting data from the wireless local network, and after successful searching, the handset receives system information, so the handset has claimed

parts for monitoring activity and polling subscriber data of the wireless local network (paragraph 0016).

Le teaches, the mobile can initiate a location update either on its own or on command from the network – periodic location update. The location areas are identified by Location Area Identification – LAC (column 9, lines 4 – 20). Each cell has the cell identity – CI, which the network node broadcasts. Here, when it is initiated by the network command, which is the same as the claimed polling subscriber data of the wireless local network. The mobile station 110 consists of Mobile Equipment 124, and SIM 126 (Fig. 1, Fig. 9/930 – dual mode terminal), the SIM/USIM card 205 contains the International Mobile Subscriber Identity – IMSI, used to identify the subscriber to the system, a secret key for authentication and **other information** (column 6, lines 21 – 29).

Here, the other information can include the specific subscriber data, type/identity number, a subscriber identification, a password, a secret key for data encryption and decryption, and an address of an access node.

Le further teaches, handovers between UMTS and GSM (Fig. 9).

It would have been obvious to one of ordinary skill in the art, at the time of invention, to modify mobile unit having internet protocol functionality of Reddy, wherein, the handset with USIM card (Fig. 2/200), that the handset polls specific subscriber data of the wireless local network (Le, Figs. 1 and 2), and the mobile

station can initiate update the subscriber location information or react on network command, for reducing a waste of processing load on the terminal and the various network nodes (Le, column 2, lines 54 – 58), and the mobile station selectively transmits information to one or more networks for establishing a communications link with the networks (Reddy, paragraph 0016).

Regarding claims 17 and 24, Reddy discloses all the claimed features,

but, is silent on, “polling a temporary status of at least one of the wireless local network and the specific subscriber data of wireless local network at periodic intervals”.

Reddy discloses, when request to connect the MS 110 is received – S1, the PLMN and IMSI information is transferred from the USIM or SIM card 115 to the handset 110 for facilitating an initial cell search and to camp on the cell determined from the search – S2. After successful camping on a cell MS or UE receives system information. A communication link between the MS or UE 105 and a UTRAN node 120 is established, and system information is sent from the UTRAN node 120 to the MS or US 105 – S3A and S3B (Fig. 1), as above.

Here, the handset is searching for cell, teaches the handset is monitors the network and collecting data from the wireless local network, and after successful searching, the handset receives system information, so the handset has claimed

parts for monitoring activity of the wireless local network (paragraph 0016), as in claim 23 above.

Le teaches, the mobile can initiate a location update either on its own or on command from the network – periodic location update. The location areas are identified by Location Area Identification – LAC (column 9, lines 4 – 20). Each cell has the cell identity – CI, which the network node broadcasts. Here, when it is initiated by the network command, which is the same as the claimed polling subscriber data of the wireless local network. The mobile station 110 consists of Mobile Equipment 124, and SIM 126 (Fig. 1, Fig. 9/930 – dual mode terminal), the SIM/USIM card 205 contains the International Mobile Subscriber Identity – IMSI, used to identify the subscriber to the system, a secret key for authentication and **other information** (column 6, lines 21 – 29).

Here, the other information can include the specific subscriber data, type/identity number, a subscriber identification, a password, a secret key for data encryption and decryption, and an address of an access node, as in claim 23 above.

Le further teaches, handovers between UMTS and GSM (Fig. 9), as in claim 23 above.

Regarding claims 18 and 25, Reddy discloses all the claimed features,

but, is silent on, "the specific subscriber data includes a type/identity number, a subscriber identification, a password, a secret key for data encryption and decryption and an address of an access node".

Le teaches, the mobile can initiate a location update either on its own or on command from the network – periodic location update. The location areas are identified by Location Area Identification – LAC (column 9, lines 4 – 20). Each cell has the cell identity – CI, which the network node broadcasts. Here, when it is initiated by the network command, which is the same as the claimed polling subscriber data of the wireless local network. The mobile station 110 consists of Mobile Equipment 124, and SIM 126 (Fig. 1, Fig. 9/930 – dual mode terminal), the SIM/USIM card 205 contains the International Mobile Subscriber Identity – IMSI, used to identify the subscriber to the system, a secret key for authentication and **other information** (column 6, lines 21 – 29).

Here, the other information can include the specific subscriber data, type/identity number, a subscriber identification, a password, a secret key for data encryption and decryption, and an address of an access node, as in claim 23 above.

Le further teaches, handovers between UMTS and GSM (Fig. 9), as in claim 23 above.

Regarding claims 18 and 26, which claims, "the terminal station comprises a universal chip card which initiates the monitoring of the activity of the wireless

local network and the transmission of data to the terminal station", Reddy discloses, in 3rd Generation – 3G Universal Mobile Telecommunication Systems – UMTS, User Equipment – UE consists of Mobile Equipment – ME and a removable smart card called the UMTS Subscriber Identity Module – USIM (Fig. 1, and paragraphs 0003, 0004, 0006, 0007, 0015, 0016 and 0030), as in claim 23 above.

Reddy discloses, when request to connect the MS 110 is received – S1, the PLMN and IMSI information is transferred from the USIM or SIM card 115 to the handset 110 for facilitating an initial cell search and to camp on the cell determined from the search – S2. After successful camping on a cell MS or UE receives system information. A communication link between the MS or UE 105 and a UTRAN node 120 is established, and system information is sent from the UTRAN node 120 to the MS or US 105 – S3A and S3B (Fig. 1). The handset has unique handset identity for transmitting, receiving and processing wireless communications. The handset selectivity transmits information to one or more networks for establishing a communication link with the networks.

Here, the handset is searching for cell, teaches the handset is monitors the network, and after successful searching, the handset receives system information, so the handset has claimed parts for monitoring activity of the wireless local network (paragraph 0016), as in claim 23 above.

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Claims 20 – 22, 27 - 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reddy, US PGPub: US 2004/0043791A1 Mar. 4, 2004, provisional application 60/382,361 May 22, 2001, and in view of Le, US Patent: US 6,556,820 B1, Apr. 29, 2003, as in claim 16 above, and in further view of 3GPP TS 31.111 version 4.5.0 Release 4, 2001-12.

Regarding claims 20 and 27, Reddy and Le discloses all the claimed features, but, are silent on, “the terminal station is suitable for notifying the universal chip card of a deactivation of the wireless local network”.

The technical specification 3GPP TS 31.111 version 4.5.0 Release 4, Dec. 2001 teaches, once the ME has made its attempt to execute a proactive command from the UICC, the ME shall inform the UICC of the success or otherwise of that command, by using TERMINAL RESPONSE. This message gives the command details, including the number of command, a general result and sometimes more specific information (Section: 6.7). It also teaches, ME informs UICC for NO SERVICE is currently available, NO radio resource currently available, which reads on the claimed “the terminal station is suitable for notifying the universal chip card of a deactivation of the wireless local network”.

It would have been obvious to one of ordinary skill in the art, at the time of invention, to modify mobile unit having internet protocol functionality of Reddy, wherein, the handset with USIM card (Fig. 2/200), that the handset polls specific subscriber data of the wireless local network (Le, Figs. 1 and 2), and the mobile station can initiate update the subscriber location information or react on network command, for reducing a waste of processing load on the terminal and the various network nodes (Le, column 2, lines 54 – 58), and the mobile station selectively transmits information to one or more networks for establishing a communications link with the networks (Reddy, paragraph 0016), and further notifying the status information to the universal chip card of the commands initiated by the universal chip card, for avoiding suspension of service provisioning to the user and to allow the ME access to the 3G functionality of the UICC if a USAT application is taking an unreasonable amount of time to complete execution (3GPP standard, section 6.1, lines 5 – 10).

Regarding claims 21 and 28, Reddy and Le discloses all the claimed features,

but, are silent on, “the universal chip card is suitable for initiating a cleardown of the logical connection between the wireless local network and the terminal station”.

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The technical specification 3GPP TS 31.111 version 4.5.0 Release 4, Dec. 2001 teaches, the UICC can issue variety of commands like DISPLAY TEXT, POLL INTERVAL, RECEIVE DATA, PROVIDE LOCAL INFORMATION, SEARVICE SEARCH, SET UP CALL – disconnecting all other calls and many more (section 6.1). Here, disconnecting call reads on the claimed “the universal chip card is suitable for initiating a cleardown of the logical connection between the wireless local network and the terminal station”.

It would have been obvious to one of ordinary skill in the art, at the time of invention, to modify mobile unit having internet protocol functionality of Reddy, wherein, the handset with USIM card (Fig. 2/200), that the handset polls specific subscriber data of the wireless local network (Le, Figs. 1 and 2), and the mobile station can initiate update the subscriber location information or react on network command, for reducing a waste of processing load on the terminal and the various network nodes (Le, column 2, lines 54 – 58), and the mobile station selectively transmits information to one or more networks for establishing a communications link with the networks (Reddy, paragraph 0016), and further notifying the status information to the universal chip card of the commands initiated by the universal chip card, for avoiding suspension of service provisioning to the user and to allow the ME access to the 3G functionality of the UICC if a USAT application is taking an unreasonable amount of time to complete execution (3GPP standard, section 6.1, lines 5 – 10), as in claim 20 above.

Regarding claims 22 and 29, Reddy and Le discloses all the claimed features, but, are silent on, “the terminal station is suitable for acknowledging all data transmitted”.

The technical specification 3GPP TS 31.111 version 4.5.0 Release 4, Dec. 2001 teaches, once the ME has made its attempt to execute a proactive command from the UICC, the ME shall inform the UICC of the success or otherwise of that command, by using TERMINAL RESPONSE. This message gives the command details, including the number of command, a general result and sometimes more specific information (Section: 6.7). It also teaches, ME informs UICC for NO SERVICE is currently available, NO radio resource currently available, which reads on the claimed “the terminal station is suitable for notifying the universal chip card of a deactivation of the wireless local network”, as in claim 20 above.

It would have been obvious to one of ordinary skill in the art, at the time of invention, to modify mobile unit having internet protocol functionality of Reddy, wherein, the handset with USIM card (Fig. 2/200), that the handset polls specific subscriber data of the wireless local network (Le, Figs. 1 and 2), and the mobile station can initiate update the subscriber location information or react on network command, for reducing a waste of processing load on the terminal and the

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various network nodes (Le, column 2, lines 54 – 58), and the mobile station selectively transmits information to one or more networks for establishing a communications link with the networks (Reddy, paragraph 0016), and further notifying the status information to the universal chip card of the commands initiated by the universal chip card, for avoiding suspension of service provisioning to the user and to allow the ME access to the 3G functionality of the UICC if a USAT application is taking an unreasonable amount of time to complete execution (3GPP standard, section 6.1, lines 5 – 10), as in claim 20 above.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

1. Rajaniemi teaches, the mobile station may monitor location area identifiers of several different core networks broadcast by the UMTS access network. The mobile station reserves a radio connection for signaling from the access network and transmits a location updating message to a core network. The mobile station monitors the broadcast location area identifiers of at least those core networks wherein it is active at the moment.
US PGPub: US 2002/0088670 A1 Jul. 4, 2002.
2. Ovesjo teaches handover between differing radio access technologies.
US Patent: US 7,181,218 B2 Feb. 20, 2007.
3. Mukherjee teaches, collecting dynamic presence information based at least in part on the client device capabilities and the presence configuration.
US PGPub: 2003/0073440 A1 Apr. 17, 2003.
4. Uskela teaches, preventing unauthorized use of a telecommunication network service. Specifically Fig. 3 shows ME informs USIM in the case of verification succeeded – step 3-11 to get IMEI, and ME informs the user for verification failed – step 3-10.
US Patent: US 6,721,886 B1 Apr. 13, 2004.

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5. Muller teaches, method and system for improving the performance of inter-systems handovers.
US Patent: US 6,549,779 B1 Apr. 15, 2003.

Contact Information


Any inquiry concerning this communication from the examiner should be directed to Nimesh Patel at (571) 270-1228, normally reached on Mon-Thur. 7:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Feild, Joseph can be reached at (571) 272-4090.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Nimesh Patel
03-28-07



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SUPERVISORY PATENT EXAMINER